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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,621	08/17/2001	Yuichiro Deguchi	SON5180.70A	6301
8156 7590 05/11/2009 JOHN P. O'BANION O'BANION & RITCHEY LLP 400 CAPITOL MALL SUITE 1550 SACRAMENTO, CA 95814			EXAMINER HASHM, LISA	
			ART UNIT 2614	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/932,621

Applicant(s)

DEGUCHI, YUICHIRO

Examiner

LISA HASHEM

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 30-32, 34-37 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 30-32, 34-37, 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

FINAL DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 1-28-09 have been fully considered but they are not persuasive.
2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a user listening to a broadcast clip and wants to get additional information about that clip; see Remarks page. 11, lines 13-16; page 12, lines 5-6 and lines 13-16; page 13, lines 6-8; page 17, line 27 – page 18, line 34; page 20, lines 23-25; page 21, lines 9-11) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
3. Applicant argues that the prior art does not disclose ‘...a data marker integrated device configured for storing a data mark in response to bookmarking of a broadcast clip...’ in independent claims 1, 20, 31, 42, and 43. Examiner disagrees.

The prior art of Sasaki discloses a data marker integrated device (i.e. user's computer system) (section 0032) configured to store a data mark (i.e. software program on user's computer system generates meta-data implemented as a content header associated with digital content; content header includes digital content identifier identifying digital content) (section 0033; 0038; 0046; 0056) in response to bookmarking of a broadcast clip (i.e. selecting digital content or audio/video content and downloading digital content on user's computer system) (section 0007; 0033; 0038; 0046; 0055) (Sasaki discloses a software program operating on a user's computer

system that generates a content header and downloading digital content associated with the content header from a commercial distributor to the user's computer system). Thus, Sasaki reads on the claimed limitation.

Further, the prior art of Lehtonen discloses a data marker integrated device (Fig. 2, 21; Fig. 3, 21; i.e. headset) (section 0011-0014) configured to store a data mark (e.g. index of user files stored in a memory card of the headset; i.e. SONG NAME 1) (section 0039) in response to storing of a clip (e.g. user storing a file, such as a multimedia file, audio/video file, MP3 music file on memory card of the headset) (section 0009, 0016, 0041).

Thus, the combination of Sasaki, Lehtonen, and Hans disclose '...a data marker integrated device configured for storing a data mark in response to bookmarking of a broadcast clip...'.
4.

Further, the fact that the assignee has prior issued patents regarding a 'data marker integrated device' does not cause means to issue the claims in this instant application.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-27, 30-32, 34-37 and 41-43 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Pat. Appl. No. 2002/0077988 by Sasaki et al, hereinafter Sasaki, in view of U.S. Pat. Appl. No. 2001/0049262 by Lehtonen, in further view of U.S. Pat. Appl. No. 2002/0120577 by Hans et al, hereinafter Hans.

Regarding claim 1, Sasaki discloses a data marker integrated device communication system (Fig. 1, 10; section 0030), comprising:

a data marker integrated device (i.e. user's computer system) (section 0032) configured to store a data mark (i.e. software program on user's computer system generates meta-data implemented as a content header associated with digital content; content header includes digital content identifier identifying digital content) (section 0033; 0038; 0046; 0056) in response to bookmarking of a broadcast clip (i.e. selecting digital content or audio/video content and downloading digital content on user's computer system) (section 0007; 0033; 0038; 0046; 0055)

(Sasaki discloses a software program operating on a user's computer system that generates a content header and downloading digital content associated with the content header from a commercial distributor to the user's computer system);

said data marker integrated device comprising a first device (i.e. user's computer system) which is configured for local, short range, communication (section 0032);

a second device (Fig. 3A; i.e. portable media device) (section 0035-0037) configured for establishing a first communication connection with the first device to receive said data mark from said first device (section 0035; 0040; 0046; 0056)

(Sasaki discloses the user's computer system transfers the downloaded digital content to a portable media device that can playback stored digital content);

said second device configured for establishing a separate second connection (section 0046);

a server (i.e. kiosk or another source) configured to connect over said second connection to said second device for data communication through said second device with said first device (section 0032; 0035; 0046; 0047)

(Sasaki discloses connecting the portable media device to a kiosk to download digital content based on the content header originally from the user's computer system);

said second device configured for interfacing with a user in response to communication with said first device and/or said server (section 0035; 0043)

(Sasaki discloses a user of the portable media device can depress a receive button to receive digital content);

said server is configured for retrieving playlist data (i.e. digit content such as audio or video in a transfer file) (section 0007; 0030; 0047) in response to receipt of said data mark (i.e. content header) from said first device (section 0032; 0047; 0056)

(Sasaki discloses the portable media device can request access to the transfer file including digital contents which is retrieved by the kiosk);

and said server is configured for communicating over a connection with a user terminal (i.e. another portable media device) so that said user terminal can access said playlist data through a user account (i.e. licensed user; registered portable media device and playback software) (section 0040) on said server when connected over said connection (section 0045; 0046; 0047; 0050) (Sasaki discloses the portable media device can transfer the content header originally from the user's computer system to another portable media device (Fig. 7: 198, 204) and the another portable media device is registered with the system and a user of the another portable media device can access the kiosk for the transfer file including digital contents).

Sasaki discloses a data mark provides a means by which digital content may be identified by devices in the distribution system. However, Sasaki does not disclose: the data marker integrated device configured for local, short range, wireless communication; the second device configured for establishing a first wireless communication and a second wireless communication; and said server configured for communicating over a data network with a user terminal.

Lehtonen discloses a data marker integrated device communication system (Fig. 3), comprising:
a data marker integrated device (Fig. 2, 21; Fig. 3, 21; i.e. headset) (section 0011-0014) configured to store a data mark (e.g. index of user files stored in a memory card of the headset; i.e. SONG NAME 1) (section 0039) in response to storing of a clip (e.g. user storing a file, such as a multimedia file, audio/video file, MP3 music file on memory card of the headset) (section 0009, 0016, 0041);

said data marker integrated device comprising a first device (Fig. 3: 27, BT2) which is configured for local, short range, wireless communication (section 0014-0015; 0027); a second device (Fig. 2, 22; Fig. 3, 22; i.e. mobile telephone) (section 0035) configured for establishing a first wireless communication connection (i.e. Bluetooth protocol connection) with the first device to receive said data mark from said first device (section 0037-0040); and said second device configured for establishing a separate second wireless connection (i.e. Internet) (section 0041); a server (i.e.. computer) configured to connect over said second wireless connection to said device for data communication through said second device with said first device (section 0041) (i.e. sending files from the computer to the headset via the mobile telephone); said second device configured for interfacing with a user (Fig. 3: UI) in response to said communication with said first device and/or said server (section 0035-0039, 0041; 0042).

Again, Sasaki discloses the claimed system except Sasaki does not disclose a first wireless communication connection, a second wireless communication connection, and a data network. However, the claimed feature of a first wireless communication connection and a second wireless communication connection was old and well known in the art. Lehtonen clearly teaches such concept.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sasaki to include a first wireless communication connection and a second wireless communication connection as taught by Lehtonen. In other words, one of ordinary skill in the art would have been lead to make such a modification of Sasaki to include a data marker integrated device configured for local, short range, wireless communication, such as

the headset of Lehtonen, to the system of Sasaki so the data marker integrated device can communicate with a second device over a first wireless communication connection, wherein the first and second device are in vicinity of each other. Further, one of ordinary skill in the art would have been lead to make such a modification of Sasaki to include a second wireless communication, such as the mobile telephone communicating with a computer of Lehtonen, to the system of Sasaki so the second device can establish a separate, second wireless communication connection with a server to transfer data to a first device without the second device being physically connected to the server.

Sasaki in view of Lehtonen do not disclose a data network.

Hans discloses a data marker integrated device communication system (Fig. 1 and 2), comprising:
a server (i.e. content management server; Fig. 1: 10, 11; Fig. 2, 26) is configured for retrieving playlist data (i.e. digital audio/video content) (section 0020) in response to receipt of a data mark (i.e. content identifier) from a first device (i.e. user node; Fig. 1, 12) (section 0021; 0022; 0029); and said server is configured for communicating over a data network (i.e. Internet) with a user terminal (i.e. personal computer; Fig. 2, 36) so that said user terminal can access said playlist data through a user account (i.e. user profile) on said server when connected over said data network (section 0025; 0029).

Again, Sasaki in view of Lehtonen disclose the claimed system except Sasaki discloses a user terminal is connected to the server utilizing a cable port rather than a server communicating over a data network with a user terminal. However, the claimed feature of a server

communicating over a data network with a user terminal was old and well known in the art. Hans clearly teaches such concept.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sasaki in view of Lehtonen to include a server communicating over a data network with a user terminal as taught by Hans. In other words, one of ordinary skill in the art would have been lead to make such a modification of Sasaki in view of Lehtonen to include a data network, such as the Internet of Hans, to the system of Sasaki in view of Lehtonen so a user terminal of Sasaki in view of Lehtonen can utilize the Internet to access the playlist from a server without having to be physically connected to the server.

Regarding claim 2, the system of claim 1, (Sasaki: section 0055).

Regarding claim 3, the system of claim 1, (Sasaki: section 0032; Lehtonen: section 0030-0031).

Regarding claim 4, the system of claim 1, (Lehtonen: section 0031; 0036-0037).

Regarding claim 5, the system of claim 1, (Lehtonen: section 0027; 0031).

Regarding claim 6, the system of claim 1, (Sasaki: section 0032; 0046; Lehtonen: 0037).

Regarding claim 7, the system of claim 6, (Lehtonen: Fig. 3, BT; section 0036).

Regarding claim 8, the system of claim 7, (Sasaki: section 0040; 0046; 0047).

Regarding claim 9, the system of claim 1, (Sasaki: section 0038; 0042; 0047; Lehtonen: section 0038).

Regarding claim 10, the system of claim 1, (Sasaki: section 0046; 0047).

Regarding claim 11, the system of claim 10, (Lehtonen: section 0041).

Regarding claim 12, the system of claim 11, (Lehtonen: section 0041).

Regarding claim 13, the system of claim 11, (Lehtonen: section 0041).

Regarding claim 14, the system of claim 13, (Lehtonen: section 0041; 0052).

Regarding claim 15, the system of claim 1, (Hans: section 0025).

Regarding claim 16, the system of claim 15, (Hans: section 0025).

Regarding claim 17, the system of claim 15, (Hans: section 0025).

Regarding claim 18, the system of claim 15, (Hans: section 0020-0022; 0025).

Regarding claim 19, the system of claim 18, (Sasaki: section 0038; 0042; 0055; 0056).

Regarding claim 20, please see the rejection in claim 1 to reject the method in claim 20, wherein Sasaki in view of Lehtonen in further view of Hans discloses:

transmitting said received data mark over said second wireless connection to a user account within a server (Sasaki: section 0047; Lehtonen: section 0041; Hans: section 0025; 0029); and retrieving information corresponding to said marked data from a storage unit coupled to said server (Sasaki: section 0047; 0055-056; Lehtonen: section 0041; Hans: section 0025; 0029).

Regarding claim 21, the method of claim 20, (Lehtonen: section 0027; 0031).

Regarding claim 22, the method of claim 20, (Sasaki: section 0038; 0042; 0047; Lehtonen: section 0038).

Regarding claim 23, the method of claim 22, (Sasaki: section 0038; 0042; 0047; Lehtonen: section 0038).

Regarding claim 24, the method of claim 20, (Lehtonen: section 0031; 0036-0037)

Regarding claim 25, the method of claim 20, (Lehtonen: section 0041).

Regarding claim 26, the method of claim 25, (Lehtonen: section 0041).

Art Unit: 2614

Regarding claim 27, the method of claim 25, (Lehtonen: section 0041; 0052).

Regarding claim 30, the method of claim 20, (Sasaki: section 0038; 0042; 0055; 0056).

Regarding claim 31, please see the rejection to the system in claim 1 above, to reject the method in claim 31.

Regarding claim 32, the method of claim 31, (Sasaki: section 0038; 0042; 0047; Lehtonen: section 0038).

Regarding claim 34, the method of claim 31, (Lehtonen: section 0036; 0041).

Regarding claim 35, the method of claim 31, (Lehtonen: section 0041).

Regarding claim 36, the method of claim 35, (Lehtonen: section 0041).

Regarding claim 37, the method of claim 31, (Lehtonen: section 0041; 0052).

Regarding claim 41, the method of claim 31, (Sasaki: section 0038; 0042; 0055; 0056).

Regarding claim 42, please see the rejections to claims 1 and 20 to reject the system in claim 42.

Regarding claim 43, please see the rejections to claims 1, 20, and 31 to reject the system in claim 42.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

The reference U.S. Pat. Appl. Publ. No. 2002/0145589 by Tree has a common assignee with the instant application.

This reference teaches all the limitations in claims 1, 20, 31, 42, and 43 in sections 0023 and 0041, except:
a server for communicating over an Internet connection with a user terminal so that said user terminal can access said playlist data through a user account on said server when connected over said Internet. Thus, Tree can be used in a proposed 103(a) rejection.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This proposed rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Appropriate action is required.

9. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LISA HASHEM whose telephone number is (571)272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lisa Hashem/
Examiner, Art Unit 2614
May 8, 2009
/Fan Tsang/
Supervisory Patent Examiner, Art Unit 2614